

REMARKS

Reconsideration and allowance in view of the foregoing amendments and the following remarks are respectfully requested.

By this amendment, claims 1-15, 20-24, 27, 28 and 30-33 are pending, claims 1-3, 6, 11-13, 20, 21, 24, 27, 28, 30-32 are amended, claims 16-19, 25, 26 and 29 are canceled without prejudice or disclaimer, and claim 33 is added. The drawings were amended as described below and the specification was amended to conform with the amended drawings.

Title of the Invention

On page 2 of the current Office Action, the Examiner objected to the Title of the Invention as allegedly not being clearly indicative of the invention to which the claims are directed. Applicants amended the Title of the Invention to "Apparatus And Method Of Customizing Animated Entities For Use In A Multi-Media Communication Application." Applicants submit that the amended Title of the Invention is clearly descriptive of the invention to which the claims are directed (note that new claim 33 is an apparatus claim). Therefore, Applicants respectfully request that the objection to the Title of the Invention be withdrawn.

Objection to the Drawings

On pages 2-5 of the Office Action, the Examiner objected to the drawing allegedly due to an error in a reference numeral of Fig. 9 and allegedly due to limitations in the claims not being shown in the figures. Applicants canceled claims 16-19, 25, 26 and 29 without prejudice or disclaimer, corrected the reference numeral in Fig. 9, changed Fig. 7 to Fig. 7A and further amended the figure, and inserted new Fig. 7B. Applicants submit that no new matter is added. All changes to the figures and new Fig. 7B are supported by the original

In the Drawings

Applicants are submitting annotated and replacement sheets with respect to Figs. 7 and 9 and are submitting a new figure, Fig. 7B. Applicants submit that no new matter is being introduced. The changes to the figures are supported by the originally filed specification and claims.

Attachments: Annotated Figs. 7 and 9, Replacement sheets for Figs. 1-10, including new Fig. 7B.

specification and claims, as filed. Applicants submits that the features of the pending claims are shown in the amended drawings. Therefore, Applicants respectfully request that the objection to the drawings be withdrawn.

Section 112 Rejection of Claim 11

On page 5 of the Office Action, the Examiner rejected claim 11 under section 35 U.S.C. 112, second paragraph, due to an insufficient antecedent basis problem. Applicants submit that amended claim 11 does not have the insufficient antecedent basis problem and therefore, respectfully request that the rejection of claim 11 be withdrawn.

Double Patenting Rejections

In the present Office Action, the Examiner provisionally rejected claims 1, 4, 5, 6, 10, 11, 12, 13, 15, 16, 17, 18 and 19-32 under the judicially created doctrine of obviousness-type double patenting with respect to one the following copending U.S. patent applications:

10/001120; 10/003,350; and 10/003,093. Claims 16-19, 25, 26 and 29 were canceled without prejudice or disclaimer making the rejection of claims 16-19, 25, 26 and 29 moot.

Applicants are submitting, concurrently with this amendment, a terminal disclaimer with respect to copending U.S. patent applications 10/001,120; 10/003,350; and 10/003,093.

Therefore, Applicants respectfully request that the rejection of claims 1, 4, 5, 6, 10, 11, 12, 13, 15, 16, 17, 18 and 19-32 be withdrawn.

Rejection of Claims 16, 17 and 19

On page 31 of the Office Action, the Examiner rejected claims 16, 17 and 19 under 35 U.S.C. 102(e) as allegedly being anticipated by U.S. Patent No. 6,466,213 to Bickmore. Applicants canceled claims 16, 17 and 19 without prejudice or disclaimer, thereby making the rejection moot. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of claims 16, 17 and 19.

Rejection of Claim 18

On page 33 of the Office Action, the Examiner rejected claim 18 under 35 U.S.C. 103(a) as allegedly being unpatentable over Bickmore in view of U.S. Patent No. 6,539,354 to Sutton et al. (“Sutton”). Applicants canceled claim 18 without prejudice or disclaimer, thereby making the rejection moot. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of claim 18.

Rejection of Claims 20-24 and 27-32

On page 34 of the Office Action, the Examiner rejected claims 20-24 and 27-32 under 35 U.S.C. 103(a) as allegedly being unpatentable over “Chartoon 2.0 Manual 2.0”, by Noot et al. (“Noot”) in view of U.S. Patent No. 6,018,774 to Mayle et al. (“Mayle”). Claim 29 was canceled without prejudice or disclaimer. Therefore, Applicants respectfully request that the rejection of claim 29 be withdrawn. Applicants traverse the rejection with respect to claims 20-24. The amendments to claims 20 and 24 broaden the scope of the claims. Applicants submit that amended claim 27 and 30-32 obviate the rejection.

Independent claim 20 is directed to a method of enabling sender customization of an animated entity for use in delivering a multi-media message. The method includes, among other things, receiving from a sender, over a network, an image of an entity to be used as the animated entity, and requesting the sender, over the network, to mark a plurality of facial features on the entity and receiving the facial features marked by the sender.

As admitted by the Examiner, on page 35 of the Office Action, Noot fails to disclose or suggest that the image received from the sender is received over the Internet. Applicants submit that Noot also fails to disclose or suggest that the image received from the sender is received over a network.

Mayle discloses a system for the creation of electronic postcards (Mayle, at col. 1, lines 5-7). Mayle is completely devoid of disclosing an animated entity. Assuming *arguendo* that Mayle discloses receiving from a sender, via a network, an image of an entity, Mayle does not disclose or suggest that the entity is animated. Further, Mayle does not disclose modifying facial features of an entity. Therefore, Mayle has no need for additional information regarding the facial features of an entity in an image and does not disclose or suggest requesting the sender, via the network, to mark facial features on the entity and receiving the facial features marked by the sender.

For at least the above-mentioned reasons, even if the combination of Noot and Mayle provides a method that includes receiving an image from a sender via a network, a point which Applicants do not concede, the combination does not disclose or suggest requesting the sender, via the network, to mark the facial features of the entity and receiving the facial features marked by the sender, as required by claim 20. Applicants submit that the combination would provide for receiving, over a network, the image of an entity and locally, without the use of the network, requesting a user to mark the facial features of the entity and receiving the facial features of the entity from the user. However, because the sender is remote from the system that provides for the marking of facial features, the user who marks the facial features of the entity cannot be the remotely located sender.

Because the combination of Noot and Mayle fails to disclose or suggest requesting, via a network, the sender to mark the facial features on the entity and receiving the facial features marked by the sender, as required by claim 20, Applicants submit that claim 20 is patentable over Noot in view of Mayle and respectfully request that the rejection of claim 20 be withdrawn.

Claims 21-23 depend from claim 20 and are patentable over Noot in view of Mayle for at least the reasons discussed with respect to claim 20, Therefore, Applicants respectfully request that the rejection of claims 21-23 be withdrawn.

Claims 24 and 27 are similar to claim 20 and are patentable over Noot in view of Mayle for reasons similar to those provided with respect to claim 20. Therefore, Applicants respectfully request that the rejection of claims 24 and 27 be withdrawn.

Claims 28 and 30-32 depend from claim 27 and are patentable over Noot in view of Mayle for at least the reasons provided with respect to claim 27. Therefore, Applicants respectfully request that the rejection of claims 28 and 30-32 be withdrawn.

Rejection of Claim 25

On page 40 of the Office Action, the Examiner rejected claim 25 under 35 U.S.C. 103(a) as allegedly being unpatentable over Noot in view of Mayle, and further in view of U.S. Patent No. 5,537,662 to Sato et al. ("Sato"). Claim 25 was canceled without prejudice or disclaimer. Therefore, Applicants respectfully request that the rejection of claim 25 be withdrawn.

Rejection of Claim 26

On page 42 of the Office Action, the Examiner rejected claim 26 under 35 U.S.C. 103(a) as allegedly being unpatentable over Noot, in view of Mayle, and further in view of U.S. Patent No. 5,537,662 to Sato and U.S. Patent No. 5,963,217 to Grayson et al. ("Grayson"). Claim 26 was canceled without prejudice or disclaimer. Therefore, Applicants respectfully request that the rejection of claim 26 be withdrawn.

Rejection of Claims 1, 2, 4-6, 12 and 13

On page 43 of the Office Action, the Examiner rejected claims 1, 2, 4-6, 12 and 13 under 35 U.S.C. 103(a) as allegedly being unpatentable over Noot, in view of Mayle and Sato, and further in view of “Web-enabled Speech Driven Facial Animation”, by Ming Ouhyoung et al. (“Ouhyoung”). A feature of original claim 2 was moved to claim 1. Applicants submit that the amendments to claim 1 and 12 obviate the rejection. Applicants traverse the rejection with respect to original claim 2.

Amended claim 1 is directed to a method of creating an animated entity for delivering a multi-media message from a sender to a recipient. The method includes, among other things, receiving from a sender an image file to a server, where the image file has associated sender-assigned name, gender, category and indexing information. Further, the category information relates to whether the animated entity will be generally available or only available to the sender.

On page 45 of the Office Action, the Examiner admitted that Noot fails to disclose or suggest that the category information relates to whether the animated entity will be generally available or only available to the sender. The Examiner relied on Mayle, Fig. 2, col. 5, lines 53-61, and col. 7, lines 7-20 to disclose this feature. Applicants submit that Mayle does not disclose or suggest this feature.

Mayle, at col. 5, lines 53-62, discloses:

The Card Database 63 also stores the date that the card was sent and the number of times that the card has been viewed. The data for a card is typically stored for 14 days (the number of days is a number set when the system is configured, and is not a limitation of the server storage time). After that point the permanent card and image data may be automatically deleted. The data is also deleted after the card has been viewed 15 times (this number is also set when the system is configured).

Thus, Mayle discloses that data is available for a predetermined time (14 days) or until an electronic postcard has been viewed a predetermined number of times (15 times). However, apparently, all data stored in Card Database 63 is treated in the same manner. Therefore,

there is no category information with respect to the image file. Either the data is available or it is not available based on a length of time the data has been stored or the number of times it has been viewed. Further, Mayle, at col. 5, lines 44-51, discloses that a card key is created when the card is sent and that the card key is required to retrieve the card data. Thus, when the data is available, it is only available to those who have been given the key.

Mayle, at col. 7, lines 7-20, discloses:

Graphic data uploaded by the user at the user computer 10 may be supplied from a variety of sources. For instance graphical data representing drawings created by programs such as Corel Draw (Corel Corporation, Ottawa, Ontario, Canada), Adobe Illustrator or Adobe Photoshop (both of Adobe Systems Incorporated, Seattle, Wash.) can be used as image data for uploading. For graphical data representing digital photos, various sources of data are possible. As illustrated in FIG. 1, the user computer can receive data from a digital camera 15, video camera 14, scanner 12, or from a film processor who provides electronic image data. In addition to the different sources, a variety of graphical data formats can be used to encode the image information. In the preferred embodiment, graphical data is provided in the JPEG or GIF format.

Thus, Mayle discloses that graphic data may be uploaded from various sources and may be in a variety of formats. However, Mayle fails to disclose or suggest that the category information relates to whether the animated entity will be generally available or only available to the sender. Either the data is available to anyone who has the card key or it is not available to anyone because it was deleted.

Applicants submit that Sato and Ouhyoung fail to disclose or suggest, either separately or in combination with Noot and Mayle, that the category information relates to whether the animated entity will be generally available or only available to the sender. Therefore, Applicants respectfully request that the rejection of claim 1 be withdrawn.

Claims 2 and 4-6 depend from claim 1 and are patentable for at least the reasons provided with respect to claim 1. Therefore, Applicants respectfully request that the rejection of claims 2 and 4-6 be withdrawn.

Amended claim 12 is similar to amended claim 1 and is patentable over the cited references for reasons similar to those provided with respect to claim 1. Therefore, Applicants respectfully request that the rejection of claim 12 be withdrawn.

Claim 13 depends from claim 12 and is patentable over the cited references for at least the reasons discussed above with respect to claim 12. Therefore, Applicants respectfully request that the rejection of claim 13 be withdrawn.

Rejection of Claim 3

On page 49 of the Office Action, the Examiner rejected claim 3 under 35 U.S.C. 103(a) as allegedly being unpatentable over Noot, Mayle, Sato, Ouhyoung, and Grayson. Applicants submit that the amendments to claim 1 obviate the rejection.

Claim 3 depends from claim 1, which is patentable over Noot, in view of Mayle and Sato, and further in view of Ouhyoung for at least the reasons provided with respect to claim 1. Applicants submit that Grayson also fails to satisfy the deficiencies of Noot, Mayle, Sato and Ouhyoung. Therefore, Applicants respectfully request that the rejection of claim 3 be withdrawn.

Rejection of Claims 7, 8 and 14

On page 50 of the Office Action, the Examiner rejected claims 7, 8 and 14 under 35 U.S.C. 103(a) as allegedly being unpatentable over Noot, Mayle, Sato, Ouhyoung and U.S. Patent No. 6,532,011 to Francini et al. ("Francini"). Applicants respectfully traverse the rejection.

Claims 7 and 8 depend from claim 1, which is patentable over Noot, Mayle, Sato and Ouhyoung for the reasons mentioned above with respect to claim 1. Applicants submit that Francini also fails to satisfy the deficiencies of Noot, Mayle, Sato and Ouhyoung. Further, claim 7 and dependent claim 8 are patentable for reasons of their own. For, example, claim 7

recites presenting the sender with an option to choose textures for teeth, eyes and a tongue.

On page 50 of the Office Action, the Examiner admitted that Noot, Mayle, Sato and Ouhyoung do not disclose or suggest presenting the sender with an option to choose textures for teeth, eyes and a tongue. The Examiner relied on Francini to disclose this feature.

Applicants disagree.

Francini, at col. 7, lines 59-60 discloses that “teeth have a standard texture, defined in advance.” Therefore, Francini does not disclose or suggest presenting the sender with an option to choose a texture for teeth, as required by claims 7 and 8.

For at least the above-mentioned reasons, Applicants submit that claims 7 and 8 are patentable over Noot, Mayle, Sato, Ouhyoung and Francini and respectfully request that the rejection of claims 7 and 8 be withdrawn.

Claim 14 depends from claim 12, which is patentable over Noot, Mayle, Sato and Ouhyoung for the reasons provided with respect to claim 12. Applicants submit that Francini fails to satisfy the deficiencies of Noot, Mayle, Sato and Ouhyoung. Further, claim 14 is also patentable for reasons of its own. For example, claim 14 is similar to claim 7 and is patentable over Noot, Mayle, Sato, Ouhyoung and Francini for reasons similar to those discussed with respect to claim 7.

For at least the above-mentioned reasons, Applicants submit that claim 14 is patentable over Noot, Mayle, Sato, Ouhyoung and Francini and respectfully request that the rejection of claim 14 be withdrawn.

Rejection of Claim 9

On page 51 of the Office Action, the Examiner rejected claim 9 under 35 U.S.C. 103(a) as allegedly being unpatentable over Noot, Mayle, Sato, Ouhyoung and U.S. Patent No. 6,147,692 to Shaw et al. (“Shaw”). Applicants traverse the rejection.

Claim 9 depends from claim 1, which is patentable over Noot, Mayle, Sato and Ouhyoung for at least the reasons discussed above with respect to claim 1. Applicants submit that Shaw also fails to satisfy the deficiencies of Noot, Mayle, Sato and Ouhyoung.

Further, claim 9 is patentable over Noot, Mayle, Sato, Ouhyoung and Shaw for reasons of its own. For example, claim 9 recites presenting the sender with an option to choose different teeth from a group of teeth for the animated entity. On pages 51-52 of the Office Action, the Examiner admitted that Noot, Mayle, Sato and Ouhyoung do not disclose or suggest presenting the sender with an option to choose different teeth from a group of teeth for the animated entity. The Examiner relied on Shaw to disclose or suggest this feature.

Shaw is related to morphing a graphical image (see Shaw, at col. 2, lines 40-45). On page 52 of the Office Action, the Examiner admits that Shaw fails to explicitly disclose choosing different teeth from a group of teeth, as required by claim 9. However, the Examiner went on to assert that it would be obvious that a choice of different facial features include a choice of different types of teeth from a group of teeth be included in order to provide animal type teeth for realistic morphing of animal and human facial features.

Applicants submit that neither Shaw nor any of Noot, Mayle, Sato and Ouhyoung disclose or suggest presenting the sender with an option to choose different teeth from a group of teeth for the animated entity. Applicants submit that the Examiner used impermissible hindsight to work backward from claim 9 in order to provide a suggestion for this feature. Further, Applicants submit that the Examiner failed to make a *prima facie* case of obviousness.

According to MPEP, section 2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally,

the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants submit that, for at least the above-mentioned reasons, the prior art fails to disclose or suggest the feature required by claim 9. Further, as submitted above, the combination of references, themselves, fail to teach or suggest all of the claim limitations. Therefore, at least the first and the third requirements for establishing a *prima facie* case of obviousness have not been met. In addition, the teaching or suggestion to make the claimed invention and the reasonable expectation of success must be found in the prior art. The Examiner did not provide any prior art that taught or suggested making the claimed invention.

For at least the above-mentioned reasons, Applicants submit that claim 9 is patentable over the cited references and respectfully request that the rejection of claim 9 be withdrawn.

Rejection of Claim 10

On page 52 of the Office Action, the Examiner rejected claim 10 under 35 U.S.C. 103(a) as allegedly being unpatentable over Noot, Mayle, Sato, Ouhyoung and U.S. Patent No. 4,276,570 to Burson et al. ("Burson"). Applicants submit that amended claim 1 obviates the rejection.

Claim 10 depends from claim 1, which is patentable over Noot, Mayle, Sato and Ouhyoung for at least the reasons discussed above with respect to claim 1. Applicants submit that Burson also fails to satisfy the deficiencies of Noot, Mayle, Sato and Ouhyoung. Therefore, Applicants respectfully request that the rejection of claim 10 be withdrawn.

Rejection of Claims 11 and 15

On page 54 of the Office Action, the Examiner rejected claims 11 and 15 under 35 U.S.C 103(a) as allegedly being unpatentable over Sato, in view of Francini and further in view of U.S. Patent No. 5,638,502 to Murata. Applicants submit that amended claims 1 and 12 obviate the rejection.

Claim 11 depends from claim 1, which is patentable over Sato for reasons discussed with respect to claim 1. Applicants submit that neither Francini nor Murata, either separately or in combination, satisfy the deficiencies of Sato. Therefore, Applicants submit that claim 11 is patentable over Sato, in view of Francini and further in view of Murata and respectfully request that the rejection of claim 11 be withdrawn.

Claim 15 depends from claim 12, which is patentable over Sato for reasons provided with respect to claim 12. Applicants submit that neither Francini nor Murata, either separately or in combination, satisfy the deficiencies of Sato. Therefore, Applicants submit that claim 15 is patentable over Sato, in view of Francini and further in view of Murata and respectfully request that the rejection of claim 15 be withdrawn.


CONCLUSION

Having addressed all rejections and objections, Applicants respectfully submit that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

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FIG. 7A

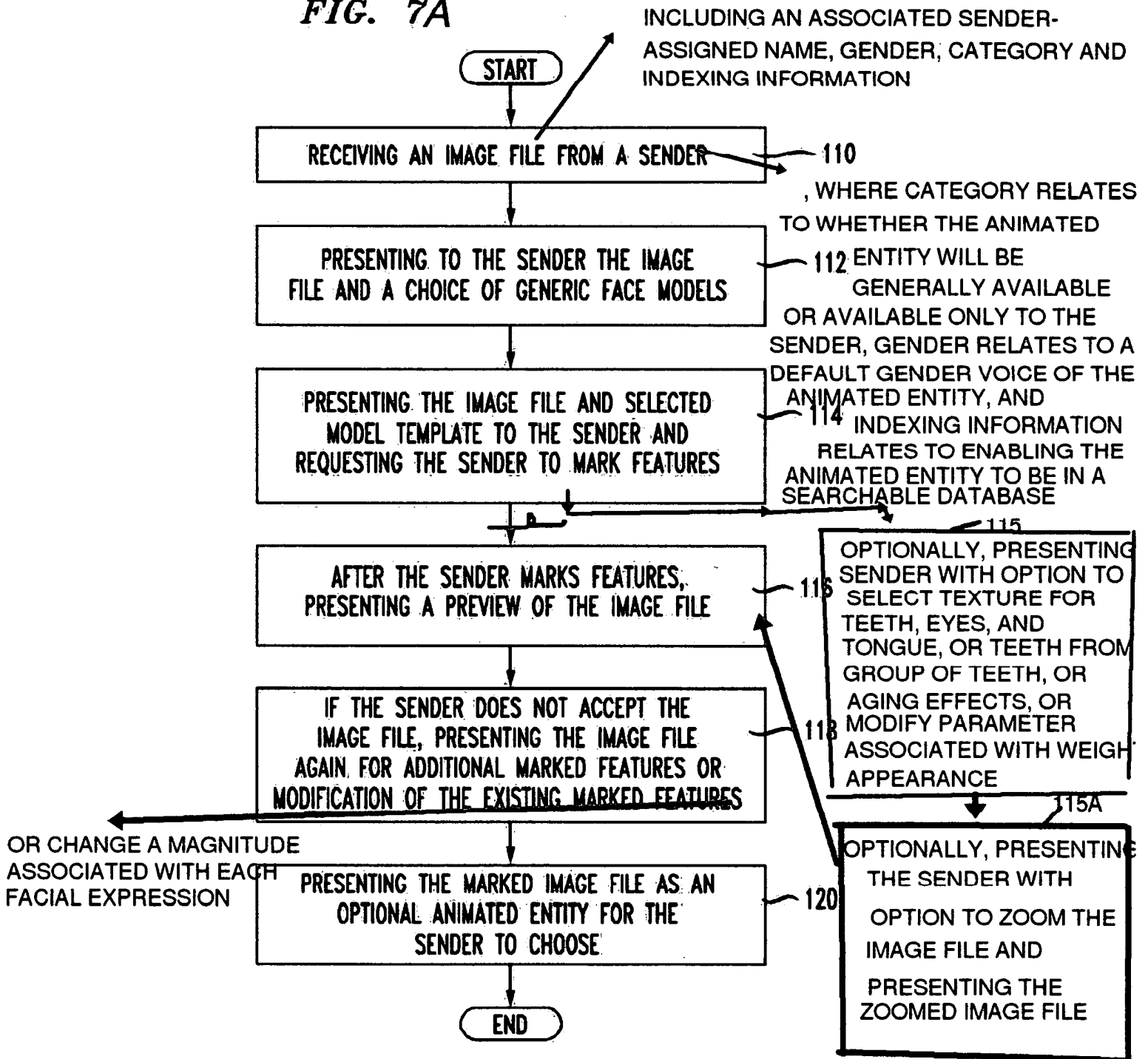


FIG. 9

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